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Docket No. SUN-DA-141T
Serial No. 10/758,346Remarks

Claims 1-15 are pending in the subject application. Upon entry of these remarks, claims 1-15 will be remain before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Specification paragraph [0006] has been amended to correct a typographical error. No new matter has been introduced by this amendment.

Claims 1-15 stand rejected under 35 USC §102(e) as anticipated by Park *et al.* (6,656,788). Applicant respectfully traverses because Park *et al.* does not teach each and every limitation of the subject invention as claimed in claims 1-15. The Office Action at page 2 states that Park *et al.* discloses "forming a second insulating layer 34 including a transition element oxide on the first insulating layer 32 (fig. 3 and text on col. 3, lines 42 to col. 4, first paragraph)." However, Park *et al.* discloses forming a second insulating layer by depositing an amorphous TaON film. In particular, Park *et al.* teaches depositing an amorphous Ta-Oxide-Nitride (TaON) through inducing a surface chemical reaction so that an amorphous TaON thin film can be obtained and then crystallizing the amorphous TaON through an annealing or a rapid thermal process (*see* col. 3, line 55 - col. 4, line 14).

In contrast to Park *et al.*, subject claim 1 specifies a method comprising forming a second insulating layer by depositing a transition element on the first insulating layer and performing a reoxidation process; and subject claim 13 specifies a method comprising forming a second insulating layer by depositing a transition element oxide on the first insulating layer. As described above, Park *et al.* does not teach such processes. Moreover, an amorphous Ta-Oxide-Nitride should not be characterized as a transition element oxide because the "Oxide-Nitride" portion of TaON has different chemical properties than an "Oxide" of Ta.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Cornell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSI Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims,

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determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSII, supra; Kalman v. Kimberly-Clarke*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983) (emphasis added). 221 USPQ at 485.

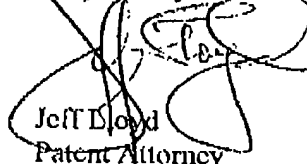
As *Park et al.* does not teach the claimed forming a second insulating layer by depositing a transition element on the first insulating layer and performing a reoxidation process (as in claim 1), or by depositing a transition element oxide (as in claim 13), it does not teach each and every element of the subject invention. Therefore, it cannot anticipate. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-15 under 35 U.S.C. §102(e).

In view of the foregoing remarks and amendments to the claims, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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